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10/733,025	12/09/2003	Timothy A. Hazzard	200901493-1	7501
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EXAMINER REFAI, RAMSEY				
ART UNIT 3627		PAPER NUMBER		
NOTIFICATION DATE 01/15/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/733,025

Applicant(s)

HAZZARD ET AL.

Examiner

Ramsey Refai

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Amendment filed September 30, 2009. Claims 1, 3-7, 9-13, and 15-20 remain presented for examination.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.
 - In the remarks, the Applicant argues that the combination would not have been obvious and is based on inexpressible hindsight.

In response, the Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Teper et al teach using user specified preferences to customized service to individual users (**see at least column 3, line 65-column 4, line 5**) but fails to *explicitly teach receiving, from the user system, a user-specified search value of a search variable directed to a feature of the services; querying the directory of the plurality of services according to the search value; and identifying the subset of the directory according to the search value*. However, in the same field of endeavor, Grabelsky et al teach a method for providing services to a user. The method allows the user to enter a query into the user device. The query is then used to search a database to find matches. A response with a portion of the list of matches found is sent to the user (**see at least figs 7-9,**

column 1, line 57-column 2, line 3). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Teper et al and Grabelsky et al because doing so would allow the system in Teper to use a search value provided by the user as a way to customized the services for the requesting user. Furthermore, Teper et al and Grabelsky et al fail to explicitly teach the user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services. However, it would have been obvious to one of ordinary skill in the art to modify Teper et al and Grabelsky et al to include this feature because doing so would allow the system to identify a subset of the directory based on the software application desired. The modification would require merely modifying the data in the database to associate an additional search value that indicates a software application of that service(s). The subset of the directory that is identified according to the search value obtained from the user remains unchanged regardless of the search value used.

It is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention. Thus the claimed subject matter likely would have been obvious under **KSR**.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3-7,9-13, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al (US. 5,815,665) in view of Grabelsky et al (US 7,480,723).
4. As per claim 1, Teper et al teach a method for providing access to a service, comprising:
providing access of a directory of a plurality of services at a portal communicating with a user system (see at least column 5, lines 49-55, column 8, line 64-column 9, line 24;

customized services for individual users), the plurality of services associated with a plurality of third party vendors, at least some of the plurality of services comprising use of corresponding software applications (**see at least column 1, lines 13-31, column 8, lines 7-19**);

receiving a selection of one or more selected services of the identified subset of services from the user system (**see at least column 9, lines 9-53, fig 2; user is presented with customized services and selects a service provided by a service provider**, the one or more selected services associated with one or more conditions governing access to the one or more selected services; receiving a user identifier; linking the one or more selected services with the user identifier; and allowing the user identifier access to the one or more selected services according to the one or more conditions (**see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18**).

Teper et al teach using user specified preferences to customized service to individual users (**see at least column 3, line 65-column 4, line 5**) but fails to *explicitly* teach *receiving, from the user system, a user-specified search value of a search variable directed to a feature of the services; querying, by at least one processor, the directory of the plurality of services according to the search value; and identifying, by at least one processor, a subset of the services of the directory according to the search value*. However, in the same field of endeavor, Grabelsky et al teach a method for providing services to a user. The method allows the user to enter a query into the user device. The query is then used to search a database to find matches. A response with a portion of the list of matches found is sent to the user (**see at least figs 7-9, column 1, line 57-column 2, line 3**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Teper et al and Grabelsky et al because doing so would allow the system in Teper to use a search value provided by the user as a way to customized the services for the requesting user.

Furthermore, Teper et al and Graberlsky et al fail to explicitly teach the user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services. However, it would have been obvious to one of ordinary skill in the art to modify Teper et al and Graberlsky et al to include this feature because doing so would allow the system to identify a subset of the directory based on the software application desired. The modification would require merely modifying the data in the database to associate an additional search value that indicates a software application of that service(s). The subset of the directory that is identified according to the search value obtained from the user remains unchanged regardless of the search value used.

It is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention. Thus the claimed subject matter likely would have been obvious under **KSR**.

5. As per claim 3, Teper et al teach providing a list of a plurality of categories of the plurality of services; receiving a selected category of the plurality of categories from the user system, and wherein identifying the subset is further based on the selected category (**see at least column 5, lines 49-55, column 8, line 64-column 9, line 24**).

6. As per claim 4, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises: verifying a

passcode corresponding to the user identifier; and providing the user identifier access to the one or more selected services in response to verifying the passcode, the one or more selected services comprising at least one service furnished by at least one third party vendor **(see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18).**

7. As per claim 5, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises: determining usage of access to the one or more selected services; calculating compensation for the usage according to the one or more conditions; and providing the compensation to at least one third party vendor furnishing the one or more selected services **(see at least column 1, lines 37-41, column 8, lines 20-25).**

8. As per claim 6, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises allowing the user identifier access to the one or more selected services through the portal **(see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18).**

9. As per claims 7, 9-13, and 15-20, these claims contain similar limitations as claims 1 and 3-6 above and therefore are rejected for similar reasons.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 9:00 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
January 12, 2010
/Ramsey Refai/
Primary Examiner, Art Unit 3627